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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,701	06/16/2005	Dietmar Baumhoff	23306	4681
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K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900				
EXAMINER				
HOOK, JAMES F				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,701

Applicant(s)

BAUMHOFF ET AL.

Examiner

James F. Hook

Art Unit

3754

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-32 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 6/16/05

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on December 18th and 19th of 2002, and April 11th of 2003. It is noted, however, that applicant has not filed a certified copy of the German applications as required by 35 U.S.C. 119(b).

Election/Restrictions

It is noted that claim 31 was considered elected by the figure 1 and 2 embodiment, however, element 21 is shown only in figure 22 which is not elected, and such is not seen in elected figure 1, therefore such claim and its limitations is considered non-elected for purposes of this rejection, however, it appears the subject matter of this claim can be found in the prior art as well.

Applicant's election of group II in the reply filed on September 3, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's election of figure 1 in the reply filed on December 16, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 30 and 32 refer to claims 1-5 which are canceled and therefore it is not clear what the scope of these claims are, when it cannot be determined what limitations are intended to be included in these claims, thereby rendering the claims indefinite.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 30 recites the

broad recitation "a preshaped strip", and the claim also recites "in particular a metal strip" which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 32 recites the broad recitation "a preshaped strip", and the claim also recites "in particular a metal strip" which is the narrower statement of the range/limitation.

Claim 30 recites the limitation "the folds" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Carson (565). The reference to Carson discloses the recited pipe comprising a metal strip that is preshaped and wound with bellows like turns, there is an interlocked edge 3, joined by interfitting, the method of forming such is not limiting to the article claim, the uses of such for exhaust of a motor vehicle is merely intended use and the tube is capable of such use, and as seen in figure 8, peaks 9 can be connected together in a gas tight manner at the peak, there are bell shaped folds 8 provided as well, there is a connecting region between webs 6.

Claims 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Carson (695). The reference to Carson discloses the recited pipe comprising a metal strip that is preshaped and wound with bellows like turns, there is an interlocked edge 3, joined by interfitting, the method of forming such is not limiting to the article claim, the uses of such for exhaust of a motor vehicle is merely intended use and the tube is capable of such use, and as seen in figure 8, peaks 9 can be connected together in a gas tight manner at the peak, there are bell shaped folds 8 provided as well, there is a connecting region between webs 6.

Claims 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Carson (695). The reference to Carson discloses the recited pipe comprising a metal strip that is preshaped and wound with bellows like turns, there is an interlocked edge 3, joined by interfitting, the method of forming such is not limiting to the article claim, the

uses of such for exhaust of a motor vehicle is merely intended use and the tube is capable of such use, and as seen in figure 8, peaks 9 can be connected together in a gas tight manner at the peak, there are bell shaped folds 8 provided as well, there is a connecting region between webs 6.

Claims 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fulton. The reference to Fulton discloses the recited pipe comprising a metal strip that is preshaped and wound with bellows like turns, there is an interlocked edge 9, joined by interfitting, the method of forming such is not limiting to the article claim, the uses of such for exhaust of a motor vehicle is merely intended use and the tube is capable of such use, and as seen in figure 1, peaks 9 can be connected together in a gas tight manner at the peak, there are bell shaped folds provided as well, there is a connecting region between webs as well.

Claims 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis. The reference to Davis discloses the recited pipe for gases comprising a metal strip that is preshaped and wound with bellows like turns, there is an interlocked edge 18, joined by interfitting, the method of forming such is not limiting to the article claim, the uses of such for exhaust of a motor vehicle is merely intended use and the tube is capable of such use, and as seen in figure 4, peaks 19 can be connected together in a gas tight manner at the peak, there are bell shaped folds 7 provided as well, there is a connecting region between webs as well.

Claims 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Trihey. The reference to Trihey discloses the recited pipe comprising a metal strip that

is preshaped and wound with bellows like turns, there is an interlocked edge 61, joined by interfitting, the method of forming such is not limiting to the article claim, the uses of such for exhaust of a motor vehicle is merely intended use and the tube is capable of such use, and as seen in figure 19, peaks 61 can be connected together in a gas tight manner at the peak, there are bell shaped folds 62 provided as well, there is a connecting region between webs as well.

Claims 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fentress. The reference to Fentress discloses the recited pipe for exhaust gases comprising a metal strip that is preshaped and wound with bellows like turns, there is an interlocked edge 16, or 57, joined by interfitting or weld, the method of forming such is not limiting to the article claim, the uses is for exhaust of a motor vehicle, and as seen in figures 4-6, peaks 16, 57 can be connected together in a gas tight manner at the peak, there are bell shaped folds provided as well, there is a connecting region between webs as well.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Wltzenmann, Herbst, Stone, Habdas (042 and 851), and Vilkaitis disclosing state of the art tube structures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James F. Hook/
Primary Examiner, Art Unit 3754

JFH